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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,151	12/26/2001	Johanna Fraki	442-010769-US(PAR)	8146
2512	7590	05/03/2005	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER
			3679	
DATE MAILED: 05/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/033,151

**Applicant(s)**

FRAKI ET AL.

**Examiner**

Ernesto Garcia

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 9-12, 14-21, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Filler et al.), WO00/11827, in view of Yu et al., 6,684,087.

Regarding claim 1, Filler et al. disclose a method comprising:

identify a user of a computer (page 9, line 29) in a communication network from subscriber identity information of the user in communication network (normally a computer is identified via an ethernet address, an user's ID or password in a service provider or a communication network), the user enters the communication network using the computer (users are known to enter an internet through the computer); and associate a digital collectible trading card with the user based on the subscriber identity information received from the computer (page 2, lines 17-20; page 15, lines 28-32). However, the communication network is not a cellular mobile communication network and the computer is not a cellular mobile phone. Yu et al. disclose a computer

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being a mobile cellular phone to enter a cellular mobile communication network and use the internet to download digital collectible trading cards as an alternative to trading data over wired connections. Therefore, as taught by Yu et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cellular mobile phone in a cellular mobile communication network to enter the internet, as an alternative to wired communication, and download digital collectible trading cards. Further, applicant should note that logging on to cellular mobile communication networks is similar to wire communication networks. Normally, the phone number, the phone's SIM's number on a GSM system, or both identifies the user of the cellular mobile phone.

Regarding claim 2, Filler et al. teach the user trading the trading card with a second user (page 27, lines 12-15). The second user becomes associated with the trading card after the trade (pg. 27, lines 35-36).

Regarding claim 3, Filler et al., teach trading the trading card being performed under control of a server (pg. 27, line 15-34).

Regarding claim 5, Filler et al. teach the method further includes storing the trading card on a server and associating the trading card with the user being made at the server (pg 15, line 28 - pg. 16, line 5).

Regarding claim 6, Filler et al. teach associating indicates ownership of the trading card by the user.

Regarding claim 7, Filler et al. teach the method further includes notify the user of a given digital collectible trading card associated with a second user. The given collectible trading card is available for purchase or trade (pg. 27, line 20-22).

Regarding claim 9, Filler et al. teach the method further includes requesting to purchase the trading card before associating the trading card with the user (pg. 13, lines 30-31).

Regarding claim 10, Filler et al. teach entering an additional password at the mobile terminal (pg. 15, line 31-33). Applicant is reminded that a previous password has not been defined in claim 1 to render an additional password in claim 10.

Regarding claim 11, Filler et al., as modified above, teach the method further includes transmit a request from the cellular mobile phone to a server to send the trading card to the mobile phone; identify the user sending the request; compare the identity of the user with the user identification information associated with the trading card; and, provide the trading card to the user in response to matching the identity and the user identification information (pg. 15, lines 28 - pg. 16, line 5).

Regarding claim 12, Filler et al. teach providing the trading card to the user comprises transmit the trading card from the server to the mobile phone via the communication network; and, displaying the trading card on the mobile phone.

Regarding claims 14 and 25, Filler et al. teach the trading card includes at least one of a streamed video, an advertisement, digital music, a video clip (pg. 6, lines 9-15) and an avatar feature.

Regarding claims 15 and 26, Filler et al. teach the trading card includes at least one dynamic user-specific feature (pg. 2, lines 4-6).

Regarding claim 16, Filler et al. teach the trading card comprises data information (pg. 6, line 11), and the method further comprises updating data information of the trading card in real time based on a real event corresponding to contents of the trading card (col. 2, lines 6-11).

Regarding claim 17, Filler et al. teach updating data information of the trading card being done on request of the user (pg. 25, 2-8). Applicant is reminded that the information is accessible by a link upon being clicked by a user.

Regarding claim 18, the method further comprises adding an indicator including a certain price for the trading card (pg. 2, line 12-14).

Regarding claim 19, Filler et al., as modified above, teaches the communication network includes a cellular mobile communication network.

Regarding claim 20, the server stores digital collectible trading cards and association information identifying owners of the trading cards (pg. 9, line 3-4).

Regarding claim 21, Filler et al. disclose a digital collectible trading card system in a communication network comprising the communication network, at least one computer, and a server communicating with the computer via the communication network. However, the communication network is not a cellular mobile communication network or the computer is a mobile cellular phone. Yu et al. teach a mobile cellular phone in a cellular mobile communication network as an alternative setup to transfer data between devices in wireless connections versus wired connections. Therefore, as taught by Yu et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mobile cellular phone in the cellular communication network as wireless connection instead of a wired connection.

Considering the modification, the phone is capable of displaying and controlling of at least one digital collectible trading card associated with a user of the mobile phone. The server is capable of storing the trading card and associating the user with the trading card. Associating is based on subscriber identity information of the user in the

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mobile network received from the phone. Applicant is reminded that on a GSM network, identity information of the subscriber to the communication network is stored in a phone's SIM card. Associating messages, pictures, files, or audio has been known to occur when the cellular phone logs into the system.

Regarding claim 23, as modified above, Yu et al. teach the communication network including mobile network and internet. The mobile network is selected from a group consisting of GSM, GPRS, and UMTS.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 2 above, and further in view of Beuk et al., 5,774,673.

Regarding claim 4, Filler et al., as modified above, teaches trading the trading card with the second user includes storing the digital trading card at a first mobile terminal and transferring the trading card from the first mobile terminal to a second mobile terminal. However, trading is not transferred via a wireless communication. Beuk et al. teach in Figure 1 trading data between a first device and a second device via a wireless communication (infrared communication) to communicate and share files wirelessly. Therefore, as taught by Beuk et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to transfer the digital trading



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cards between two cellular mobile phones via a wireless communication to trade the trading cards.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 11 above, and further in view of Peppel, 6,200,216.

Regarding claim 13, Filler et al., as modified above, fails to disclose providing the user with the digital collectible trading card comprises providing the trading card for view on the mobile terminal for a limited period of time only. Peppel teaches, on column 6, in lines 29-37, providing the trading card for view on the mobile terminal for a limited period of time only to generate scarcity of the trading cards. Therefore, as taught by Peppel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the trading card to the user for a limited period of time only to generate scarcity of the trading cards.

Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as respectively applied to claims 1 and 21 above, and further in view of Treyz et al., 6,587,835.

Regarding claim 8, applicant is reminded that cellular communication networks keep location information of the phones including the phone of the user in the network

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as taught by Filler et al. in the modification above. However, Filler et al., as modified above, fails to determine vicinity of a second user based on the location information of the mobile phone of the user and of the mobile phone of the second user. Treyz et al. teach determining vicinity of a second user based on location information of a mobile phone of a user and of a mobile phone of a second user to find proximity of the second user with respect to the user (col. 45, lines 21-30). Therefore, as taught by Treyz et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine vicinity of a second user based on the location information of the mobile phone of the user and of the mobile phone of the second user to find the proximity of the second user with respect to the user.

Regarding claim 24, given the method in claim 8 above, the cellular communication network requires a location register to locate the position of the cellular phone. Therefore, as taught by Treyz et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a location register in the cellular communication network to determine vicinity information of a second cell phone user from a first cell phone user.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filler et al., WO00/11827, in view of Yu et al., 6,684,087, as applied to claim 21 above, and further in view of Atsmon et al., 6,607,136.

Regarding claim 22, Filler et al., as modified above, fails to disclose the system further including a digital physical trading card wirelessly communicating with the cellular phone. Atsmon et al., 6,607,136, teach in Figure 1 a system further including a digital physical trading card 10 wirelessly communicating with a device 14. However, the device as shown in Figure 1 is a computer instead of a cellular mobile phone. Atsmon et al. suggests that the device 14 can be a cellular phone to make a sale transaction without the need of a smart trading card reader (col. 2, lines 34-38). Therefore, as taught by Atsmon et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the digital physical trading card wirelessly communicating with the cell phone in Yu et al. to make a sales transaction without the need of the smart trading card reader. Applicant is reminded that a computer, a PDA, a laptop computer, and a cellular phone are equivalent devices that function as a computer and the physical trading card is capable of presenting the digital collectible trading card transferred thereto independently of the cellular phone.

### ***Response to Arguments***

Applicant's arguments filed January 28, 2005 have been fully considered but they are not persuasive.

Applicant has argued that the combination of Filler and Yu finds no disclosure related to "identifying a user of a cellular mobile phone from subscriber identify

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information” as recited in claim 1. Applicant further makes the analyzes that Filler has no disclosure related to cellular mobile phones and requires a user name and password each time a user attempts to connect to the system. In response, the clause is not directly found in each of the references individually, but in the combination of the references. It is true that Filler does not explicitly state cellular mobile phones. However, Filler does state on page 10 in line 1 that a user's minimum equipment and system software can be an equivalent to a computer. Therefore, a mobile phone, equipped with an operating system (OS), is an equivalent to a computer system. Further, applicant has admitted that Filler does identify a user in the network by entering an username and password. The mere lack of Filler not explicitly disclosing cellular phones does not refute that users are not identified. Yu merely is used to provide an equivalent computer system. Therefore, in combining the references, a cellular network works similar to a wired network and also identifies a user in the cellular network. A user in a cellular network is identified by subscription information stored in the cell phone's SIM card. Once logged in to the network, whether the network is wired or wireless, associating information, messages, electronic files including movies, music, pictures, or any electronic file will occur.

Applicant further argues that computer workstations are very seldom personal enough that they are not personal devices. In response, this argument is out of scope as the issue of patentability has nothing to do whether computers are personal or not

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personal to a user. If applicant completes a survey, most respondents will indicate that their computer is very much personal.

Applicant further argues that the identification and associating methods of the combination of Filler and Yu are completely different from those of the present invention. In response, applicant's argument fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Further, there is nothing in the claims that defines what are the identification and associating methods that applicant is referring to.

Applicant further argues that Yu never even approaches the subject of handling digital collectible trading cards but images. In response to applicant's argument against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, isn't a digital collectible trading card an image? Applicant has apparently indicated that the data of the image files of Yu is not synonymous to trading cards. Yet, applicant has failed to indicate what the differences are between the two files.

Applicant further argues that Yu's user identifier is only used for finding a certain user account and for generating certain instructions. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, Filler already teaches a user identifier. There's no need to tackle Yu alone when Yu is not used to teach the user identifier but to teach that image files, which are digital collectible trading cards, have been downloaded, through the use of a cellular mobile communication network, into cell phones prior to applicant's invention.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272- 7087. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

E.G.

April 26, 2005

*Daniel P. Stodola*

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